

## REMARKS

### **Present Status of Application**

The Examiner is thanked for the thorough examination of the present application. The FINAL Office Action, however, continued to reject all pending claims 20-25, which were added in the response to the Office Action of March 27, 2006. More specifically, claims 20, 22, 23 and 25 stand rejected under 35 U.S.C 102(b) as allegedly anticipated by Shirashima et al (US patent Number 6275465). In addition, claim 21 is rejected under 35 U.S.C 103(a) as allegedly unpatentable over Shirashima et al, in view of Ota et al (US Patent Number 6721263). Further, claim 24 is rejected under 35 U.S.C 103(a) as allegedly unpatentable over Shirashima et al, in view of Haga (US Patent Number 6535476).

In response, Applicant has amended claims to overcome the rejection base on 35 U.S.C. 102(b) and 103(a). After entry of the foregoing amendments, claim 24 has been canceled and claims 20-23 and 25 are pending in the application, and for at least the reasons set forth herein, Applicant requires that all rejections be reconsidered and withdrawn.

### **Amendments Raise no New Issues and Should be Entered**

The present Office Action was accorded the status of FINAL. Applicant appreciates that entry of amendments that are made after FINAL are within the discretion of the Examiner, and may not be entered if they raise new issues. In this regard, the amendment made to independent claim essentially incorporates the subject matter of previous dependent claim 24, and cancels claim 24. Accordingly, no new issues are raised by this amendment.

### **Discussion of Office Action Rejections**

Applicant respectfully requests reconsideration of the rejections for at least the reasons set forth below. As noted above, claim 20 (as amended) now incorporates the subject matter of previous claim 24. As admitted by the Office Action, the Shirashima reference did not disclose this subject matter. Instead, the Office Action rejected claim 24 as allegedly unpatentable over the combination of Shirashima and Haga. Accordingly, Applicant's response (below) with regard to amended claim 20 will address the rejection of previous claim 24.

Independent claim 20 (as currently amended) recites:

20. A disk-anchoring device of an optical disk device, comprising:
  - a substrate;
  - a clamper frame for holding a clamper, pivoted on said substrate and having a first protrusion portion;
  - a sliding element, movably mounted on said substrate and having an inclined portion and a second protrusion portion;
    - wherein, when said sliding element is moved on said substrate, said first protrusion portion is relatively moved along said inclined portion so as to swing said clamper frame;
    - wherein, *after a disk is loaded into the optical disk device, said second protrusion portion abuts and pushes said first protrusion portion.*

(*Emphasis added.*) Claim 20 patentably defines over the cited art for at least the reason that the cited art fails to disclose the features emphasized above.

As amended, independent claim 20 defines a disk-anchoring device of an optical disk device for clamping an optical disk. The claimed disk-anchoring device comprises a clamper frame having a first protrusion portion and a sliding element having an inclined portion and a second protrusion portion. After a disk is loaded into the optical disk device, the second protrusion portion abuts and pushes the first protrusion portion.

In operation, before a disk is loaded into the optical disk device, the first protrusion portion 31 of the clamper frame 3 is positioned at the higher end of the inclined portion 63 of the

sliding element 6 as shown in amended FIG. 6. Alternatively, after the disk is loaded into the optical disk device, the first protrusion portion 31 of the clamper frame 3 is positioned at the lower end of the inclined portion 63 of the sliding element 6, and the second protrusion portion 64 of the sliding element 6 abuts the first protrusion portion 31 and pushes the clamper frame 3 downwardly as shown in amended FIG. 7 (see paragraph [0034] of the specification).

As noted above, the Office Action admits that Shirashima fails to disclose these features. Instead, the Office Action relies on Haga as allegedly disclosing this feature. Applicant respectfully disagrees.

In this regard, Haga discloses a disc clamp mechanism including a clamper holder chassis 1, clamper holder 10 and a clamper 8. Before a disk is loaded into the optical disk device, the clamper holder 10 is mounted on clamper holder chassis 1 and holds clamper 8. As noted in col. 4 and lines 44-50, as the disk 7 is transported to a predetermined position above the turntable, sliders 5 and 6 start moving so that the clamper holding chassis 1 lowers as shown in FIG. 9A and 9B. Accordingly, Haga does not teach that the slider 5 or 6 have a second protrusion portion, as specifically claimed.

Further, the clamper holder 10 of Haga is an additional element, which is mounted on the clamper holder chassis 1 for holding the clamper 8. As discussed in col. 4, line 59 to col. 5, line 7, the protruding portion 10b raises the projection part 10b so that the projection part 10b of the clamper holder 10 is upward moved apart from the disk 7 in the clamp state. The purpose, therefore, is to prevent a contact between the disk 7 and clamper holder 10 and between the clamper 8 and clamper holder 10.

In contrast, the present application provides a disk-anchoring device with a sliding element and a clamper frame. A clamper is held on the clamper frame, and not on the sliding

element. Further, a second protrusion portion is on the sliding element abuts a first protrusion portion on the clamper frame and pushes the clamper frame downwardly.

Therefore, the clamper holder 10 in Haga cannot properly be construed as, or equated to, the sliding portion in the present application. The functions of them are vastly different, and the structural interrelationships (as embodied in the claims) are patently distinct. In Haga, the protruding portion is used to raise the projection part so that the projection part of the clamper holder is moved upward, apart from the disk. However, in the present application, the second protrusion portion is used to abut a first protrusion portion on the clamper frame and push the clamper frame downwardly. Therefore, Haga does not teach a second protrusion as claimed in the present application, and one of ordinary skill in the art at the time the invention was made could not provide the disk clamping devise of Shirashima et al with a second protrusion under Haga's teaching.

Therefore, Haga fails to disclose all of the claimed elements of claim 20, and therefore does not impact the patentability of claim 20. Further, as claims 21-23 and 25 depend from claim 20, they patently define over Haga for at least the same reason.

Further still, with respect to claim 21, that claim was rejected as allegedly obvious over the combination of Shirashima and Ota. As claim 20 now incorporates the subject matter of claim 24, claim 21 could only be rejected under the more tenuous combination of Shirashima, Ota, and Haga. No such motivation exists. Further, as claims 21-23 and 25 depend from claim 20, they patently define over Shirashima for at least the same reason.

As a separate and independent basis for the patentability of all pending claims (as amended), Applicant respectfully traverses the rejections as failing to identify a proper basis for

combining the cited references. In combining the Shirashima and Haga references (which must be combined to reject claim 20), the Office Action stated only that the combination would have been obvious “because the second protrusion will stop the sliding element from sliding any further into the clamped state.” (Office Action, page 5). This alleged motivation is clearly improper in view of well-established Federal Circuit precedent. In this regard, some subjective benefit obtained only from hindsight is improper. Instead, there must be some objective teaching in the prior art itself that would lead one to make the alleged combination.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements

to derive a disk anchoring device, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some “teaching, suggestion, or reason” to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, *inter alia*, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000). The rationales relied on by the Office Action in the present application are merely generic statements, that have nothing to do specifically with the structures disclosed in

the other references. As such, these rationales cannot be properly viewed as proper motivations for combining the specific teachings of the individual references. Indeed, the generic motivations advanced by the present Office Action could be used to support a combination of ANY references, which is clearly contra to the cited Federal Circuit precedent and the clear intent of 35 U.S.C. § 103.

For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.

### Conclusion

Accordingly, Applicants respectfully submit the claim 20-23 and 25 to overcome the rejections. Specifically, the present application cannot be anticipated by Shirashima, Ota and Haga. In view of foregoing, it is believed that all pending claims are in proper condition for allowance.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,



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